



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/082,300	02/26/2002	Naoki Tsuchitoi	03500.016242.	2783

5514 7590 08/06/2008
FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

HUNTSINGER, PETER K

ART UNIT	PAPER NUMBER
----------	--------------

2625

MAIL DATE	DELIVERY MODE
-----------	---------------

08/06/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/082,300	Applicant(s) TSUCHITOI, NAOKI	
	Examiner Peter K. Huntsinger	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 11-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 11-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/16/08 has been entered.

Response to Arguments

2. Applicant's arguments filed 6/16/08 have been fully considered but they are not persuasive.

The applicant argues on pages 13 and 14 of the response in essence that: Mori '765 does not disclose a predetermined time being set independently of the specific period of time.

a. Mori '765 discloses a user may set a delete time indicating when to delete print data (col. 4, lines 56-65). The delete time is entered in a quantity of units of time (i.e. minutes) which can be considered a specific period of time. The printing system of Mori '765 designates (sets) whichever unit of time the delete time is entered with.

The applicant argues on pages 13 and 14 of the response in essence that:

Mori '765 does not disclose a second user-specified predetermined time constraint must be satisfied before print data is deleted.

b. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a second user-specified time constraint) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Claim Objections

3. Claim 1 is objected to because of the following informalities: In line 14, change "said printer controller" to "said printer". Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 2-5 and 16-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 2-5 recite the limitation "said printer controller" in line 1. There is insufficient antecedent basis for this limitation in the claims.

Claim 16 recites the limitation "said storage" in line 26. There is insufficient antecedent basis for this limitation in the claims. Claims 21 and 22 require similar correction.

Claim 17 recites the limitation "the print charge" in line 3. There is insufficient antecedent basis for this limitation in the claims.

Claim 22 recites the limitation "said printer controller" in line 16. There is insufficient antecedent basis for this limitation in the claims.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-3, 5, 11-13, 15, 18 and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taniguchi '972 in view of Mori '765.

Referring to **claim 1**, Taniguchi '972 discloses a printer controller for controlling printing of print data comprising:

storage adapted to store print data (col. 7, lines 34-39, printer receives print content data) and authentication information corresponding to the print data (col. 7, lines 21-28, user enters password into printer);

an authentication unit adapted to authenticate a user based on authentication information manually input by a user (col. 7, lines 35-39, if passwords are identical printer receives print job); and

a control unit adapted to enable said printer to print, based on user instruction, the stored print data corresponding to the authentication information if the user is authenticated by said authentication unit (col. 7, lines 35-39, if passwords are identical printer executes printing)

Taniguchi '972 does not disclose expressly deleting a job from the printer at a user specified time.

Mori '765 discloses a deletion unit adapted to delete, the print data from said storage at a predetermined time, manually set by a user (S670 of Fig. 10, col. 14, lines 49-60, printer deletes corresponding job if job has expired delete time), if a specific period of time has passed since the print data was stored in said storage, the predetermined time being set independently from the specific period of time (col. 4, lines 40-65, delete time entered by user in terms of units of time [i.e. minutes] which are a specific period of time)

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to delete a job from the printer after a user specified time. The motivation for doing so would have been to delete data that is no longer needed to obtain free storage space. Therefore, it would have been obvious to combine Mori '765 with Taniguchi '972 to obtain the invention as specified in claim 1.

Referring to **claims 2**, Taniguchi '972 discloses print data stored in said storage unit, but does not disclose expressly assigning the print data a priority level.

Mori '765 discloses wherein each print data stored in a storage is given a priority level, a printer controller further comprising a deletion unit adapted to delete one of the stored print data which is given a low priority level upon detecting that said storage cannot store the print data anymore (col. 4-5, lines 66-67, 1-10).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to assign a priority level to stored data. The motivation for doing so would have been to delete data that is less important when a storage unit is full. Therefore, it would have been obvious to combine Mori '765 with Taniguchi '972 to obtain the invention as specified in claim 2.

Referring to **claim 3**, Mori '765 discloses wherein the print data which is given the low priority level means the print data which was received earlier than any other print data received by said printer controller (col. 4-5, lines 66-67, 1-10).

Referring to **claim 5**, Mori '765 discloses a determination unit that determines at the predetermined time, for all of the print data stored in the storage (S660 of Fig. 10, col. 14, lines 49-60, printer determines whether there exists any job that has an expired print time), whether the specific period of time has passed since the print data was stored in said storage (col. 4, lines 40-65, whether a unit of time [i.e. minutes] has passed),

wherein said deletion unit deletes stored print data from the storage if the specific period of time has passed for that stored print data and does not delete the stored print

data if the specific period of time has not passed for that stored print data (col. 14, lines 49-60, printer deletes the corresponding job).

Referring to **claim 11**, see the rejection of claim 1 above.

Referring to **claim 12**, see the rejection of claim 2 above.

Referring to **claim 13**, see the rejection of claim 4 above.

Referring to **claim 15**, see the rejection of claim 5 above.

Referring to **claim 16**, Taniguchi '972 discloses a data processing method for providing a print service using an information processing apparatus for storing the print data and authentication information corresponding to the print data, and a printer, comprising:

a transmission of authentication information manually input by a user to print the print data from the printer to the information processing apparatus (S610 of Fig. 6, col. 7, lines 24-27);

authenticating a user based on the transmitted authentication information at the information processing apparatus col. 7, lines 35-39, if passwords are identical printer receives print job);

enabling the print to print, based on user instruction, the transmitted print data if the user is authenticated (col. 7, lines 35-39, if passwords are identical printer executes printing)

Taniguchi '972 does not disclose expressly deleting a job from the printer at a user specified time.

Mori '765 discloses deleting print data from said storage at a predetermined time, manually set by a user (S670 of Fig. 10, col. 14, lines 49-60, printer deletes corresponding job if job has expired delete time), if a specific period of time has passed since the print data was stored in said storage, the predetermined time being set independently from the specific period of time (col. 4, lines 40-65, delete time entered by user in terms of units of time [i.e. minutes] which are a specific period of time)

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to delete a job from the printer after a user specified time. The motivation for doing so would have been to delete data that is no longer needed to obtain free storage space. Therefore, it would have been obvious to combine Mori '765 with Taniguchi '972 to obtain the invention as specified in claim 16.

Referring to **claim 18**, Taniguchi '972 discloses wherein the print data is transmitted from the information processing apparatus to the printer with information indicating a name given to the print data corresponding to the input authentication information (Fig. 10b, col. 10, lines 46-58, printer receives and displays job generator IDs).

Referring to **claim 20**, Taniguchi '972 discloses deletion of print data from the printer after the end of printing the print data (S615 of Fig. 6, col. 7, lines 49-52).

Referring to **claim 21**, see the rejection of claim 1 above.

Referring to **claim 22**, see the rejection of claim 16 above.

8. Claims 4 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taniguchi '972 and Mori '765 as applied to claims 2 and 12 and above, and further in view of Reifman '433.

Referring to **claim 4**, Mori '765 discloses a deletion unit adapted to delete print data, but does not disclose expressly notifying a destination address when print data is deleted.

Reifman '433 discloses notification means for notifying a destination address set up when an error occurs (col. 73, lines 64-67).

At the time of the invention, it would have been obvious to one of ordinary in the art to notifying a destination address when the print data is breached. The motivation for doing so would have been to alert the user when print data is no longer stored and available for printing. Therefore, it would have been obvious to combine Reifman '433 with Taniguchi '972 and Mori '765 to obtain the invention as specified in claim 4.

Referring to **claim 14**, see the rejection of claim 4 above.

9. Claims 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taniguchi '972 and Mori '765 as applied to claim 16 above, and further in view of Arledge '294.

Referring to **claim 17**, Taniguchi '972 discloses a request of the stored print data but does not disclose expressly confirming a print charge for printing.

Arledge '294 discloses a request of the stored print data of the information processing apparatus after confirming that the print charge for printing the print data

selected by the user is paid (col. 21, lines 15-32, order is suspended until payment is received).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to charge for printing. The motivation for doing so would have been to collect a fee for a provided service. Therefore, it would have been obvious to combine Arledge '294 with Taniguchi '972 and Mori '765 to obtain the invention as specified in claim 17.

Referring to **claim 19**, Taniguchi '972 discloses transmission of a list of print data corresponding to the authentication information before transmitting the print data from the information processing apparatus (S606 of Fig. 6, col. 7, lines 1-10);

displaying, at the printer, the transmitted list of print data on a display of the printer (S607 of Fig. 6, col. 7, lines 11-15);

enabling the user to select print data from the displayed list of print data (S608 of Fig. 6, col. 7, lines 16-19);

transmitting the information identifying the selected print data from the printer to the information processing apparatus (S610 of Fig. 6, col. 7, lines 24-28); and

transmitting the selected print data from the information processing apparatus to the printer based on the transmitted information identifying the selected print data (S612 of Fig. 6, col. 7, lines 34-39).

Taniguchi '972 does not disclose expressly displaying a list of print data after the user inputs the authentication information.

Arledge '294 discloses transmission of a list of print data corresponding to the authentication information before transmitting the print data from the information processing apparatus to the printer if the user is authenticated (Fig. 19, col. 19, lines 1-13).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to display a list of print jobs after a password has been entered. The motivation for doing so would have been to protect information of the user by only providing the print job list after a password has been entered. Therefore, it would have been obvious to combine Arledge '294 with Taniguchi '972 and Mori '765 to obtain the invention as specified in claim 19.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter K. Huntsinger whose telephone number is (571)272-7435. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Peter K Huntsinger/
Examiner, Art Unit 2625

/David K Moore/
Supervisory Patent Examiner, Art Unit 2625